UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/045,158	01/15/2002	Yosato Hitaka	03500.016099	8868

5514   7590   09/15/2008
FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER
MENBERU, BENIYAM

ART UNIT	PAPER NUMBER
2625	

MAIL DATE	DELIVERY MODE
09/15/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

	Application No.	Applicant(s)
Office Action Summary	10/045,158	HITAKA, YOSATO
	Examiner	Art Unit	
	BENIYAM MENBERU	2625	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 June 2008*.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *20,24,25,27 and 29* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *20,24,25,27 and 29* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All   b)☐ Some * c)☐ None of:

      1.☒ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

Response to Arguments

1.   Applicant's arguments with respect to claims 20, 24, 25, and 27 have been

considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

2.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

3.   Claims 20, 24, 25, 27, and 29 are rejected under 35 U.S.C. 103(a) as being

unpatentable over U.S. Patent No. 7042585 to Whitmarsh et al in view of U.S. Patent

No. 6348971 to Owa et al further in view of U.S. Patent No. 6822754 to Shiohara.

Regarding claim 20, Whitmarsh et al '585 discloses a user apparatus that

communicates with a print management apparatus via a network (column 3, lines 24-30,

54-62; column 4, lines 37-46; The computer 34 is the user apparatus. The printer broker

28 is the print management apparatus using a network 30.), comprising:

notifying means for notifying said print management apparatus of a use condition which

is set according to an operation of a user (column 8, lines 60-67; column 9, lines 48-65;

The print attributes of print job 12 is the use condition. Customer 14 is user.);

print shop information obtaining means for obtaining, in advance, print shop information

for a plurality of print shops each satisfying the notified use condition, from said print

management apparatus (column 9, lines 48-65; column 10, lines 1-27, 36-45; The print

attributes of print job 12 is the use condition needed to generate the list 46(print shop

information for a plurality of print shops) of providers with the necessary capability 40. In

step 118 the user/customer obtains the list from the print broker 28 (print management

apparatus).) ;

print data forming means for forming print data by using a printer driver installed in said

user apparatus, in accordance with a print condition which is set according to the

operation of the user (column 4, lines 39-52; The "program" executing on computer 34

is the printer driver.; column 8, lines 60-66; The data file 44 (print data) is generated

based on attribute information 72, 73, 76 (set print condition).). However Whitmarsh et

al '585 does not disclose wherein the use condition including information for designating

an area where a print shop having a print apparatus is located; and

the print condition being different from the use condition and not including the

information for designating the area where the print shop having the print apparatus is

located.

Owa et al '971 discloses wherein the use condition including information for

designating an area where a print shop having a print apparatus is located (Figure 5

shows user print selection condition priority setting which includes condition of print

location (information for designating an area). Column 4, lines 65-67; column 5, lines 1-

24; For conditions which are item A (highest priority), the condition has to be met for

selection. Thus the user can set printer location as priority A. column 5, lines 30-64;

Thus printers not meeting the printer location condition are excluded in step s6 if the

print location is priority A and printers meeting the location condition are selected.); and

the print condition being different from the use condition and not including the

information for designating the area where the print shop having the print apparatus is

located (Figure 7, reference 21, column 8, lines 14-67; column 9, lines 1-29; The print

condition used for print data generation includes conditions such as color/monochrome,

resolution image, font which is different from the use condition (printer location

information).).

Having the system of **Whitmarsh et al '585** and then given the well-established

teaching of **Owa et al '971**, it would have been obvious to one of ordinary skill in the art

at the time of the invention was made to modify the system of **Whitmarsh et al '585** as

taught by **Owa et al '971**, since **Owa et al '971** stated in col. 7, lines 65-67; column 8,

lines 1-4, such a modification would provide selection for printers based on desired

location of a user.

However Whitmarsh et al '585 does not disclose judgment means for judging

whether each of the plurality of print shops included in the print shop information

obtained in advance by said print shop information obtaining means can print the print

data formed by said print data forming means, on the basis of the print condition of the

print data and the a print ability of each of the plurality of print shops; and

selection means for selecting a print shop to order print processing of the formed print

data, from among the print shops judged by said judgment means as the print shops

which can print the formed print data and print order forming means for forming a print order, including the designation of the selected print shop.

Shiohara '754 discloses judgment means for judging whether each of the plurality of print shops included in the print shop information obtained in advance by said print shop information obtaining means can print the print data formed by said print data forming means, on the basis of the print condition of the print data and the a print ability of each of the plurality of print shops (column 14, lines 27-43; The "print processing information" of all printers 31 is obtained (print shop information) in response to the temporary print request (print data formed; see (column 9, lines 52-67)) submitted to all the printers. Each printer 31 is judged to be match for print data based on printing content ("print condition") and printer 31 status (print ability). (column 14, lines 44-52; column 11, lines 6-67; column 12, lines 1-5).); and

selection means for selecting a print shop to order print processing of the formed print data, from among the print shops judged by said judgment means as the print shops which can print the formed print data and print order forming means for forming a print order, including the designation of the selected print shop (column 14, lines 52-67; column 15, lines 22-29; printer is selected in step 47. column 15, lines 39-43; print request to specific printer (designation of the selected shop).).

Having the system of **Whitmarsh et al '585** and then given the well-established teaching of **Shiohara '754**, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the system of **Whitmarsh et al '585** as

taught by **Shiohara '754**, since **Shiohara '754** stated in col. 2, Lines 11-30, such a

modification would provide a faster printing system in a printing network.

Regarding claim 24, Whitmarsh et al '585 discloses an information processing

system for processing information between a user apparatus and a print management

apparatus through communication via a network (column 3, lines 24-30, 54-62; column

4, lines 37-46; The computer 34 is the user apparatus. The printer broker 28 is the print

management apparatus using a network 30.), wherein said print management

apparatus comprises:

print shop information searching means for searching for information of a plurality of

print shops (column 9, lines 57-64; Printer broker 28 (print management apparatus

searches for print providers 22 by searching the attribute information 80.); and

print shop information transmitting means for transmitting the print shop information

searched by the print shop information searching means to said user apparatus (column

11, lines 9-12, 22-26; The print provider list 46 is supplied to the user.),

and wherein said user apparatus comprises:

notifying means for notifying said print management apparatus of a use condition which

is set according to an operation of a user (column 8, lines 60-67; column 9, lines 48-65;

The print attributes of print job 12 is the use condition. Customer 14 is user.);

print shop information obtaining means for receiving, from the print shop information

transmitting means, print shop information for the plurality of print shops searched by

the print shop searching means each satisfying the notified use condition (column 9,

lines 48-65; column 10, lines 1-27, 36-45; The print attributes of print job 12 is the use

condition needed to generate the list 46(print shop information for a plurality of print

shops) of providers with the necessary capability 40. In step 118 the user/customer

obtains the list from the print broker 28 (print management apparatus).),

print data forming means for setting a print condition forming print data by using a

printer driver installed in said user apparatus, in accordance with a print condition which

is set according to an operation of the user (column 4, lines 39-52; The "program"

executing on computer 34 is the printer driver.; column 8, lines 60-66; The data file 44

(print data) is generated based on attribute information 72, 73, 76 (set print condition).).

However Whitmarsh et al '585 does not disclose the use condition including information

for designating an area where a print shop having a print apparatus is located; and the

print condition being different from the use condition and not including the information

for designating the area where the print shop having the print apparatus is located.

Owa et al '971 discloses the use condition including information for designating

an area where a print shop having a print apparatus is located (Figure 5 shows user

print selection condition priority setting which includes condition of print location

(information for designating an area). Column 4, lines 65-67; column 5, lines 1-24; For

conditions which are item A (highest priority), the condition has to be met for selection.

Thus the user can set printer location as priority A. column 5, lines 30-64; Thus printers

not meeting the printer location condition are excluded in step s6 if the print location is

priority A and printers meeting the location condition are selected.); and the print

condition being different from the use condition and not including the information for

designating the area where the print shop having the print apparatus is located (Figure 7, reference 21, column 8, lines 14-67; column 9, lines 1-29; The print condition used for print data generation includes conditions such as color/monochrome, resolution image, font which is different from the use condition (printer location information).).

Having the system of Whitmarsh et al '585 and then given the well-established teaching of Owa et al '971, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the system of Whitmarsh et al '585 as taught by Owa et al '971, since Owa et al '971 stated in col. 7, lines 65-67; column 8, lines 1-4, such a modification would provide selection for printers based on desired location of a user.

However Whitmarsh et al '585 does not disclose a judgment means for judging whether each of the plurality of print shops included in the received print shop information, can print the print data formed by said print data forming means, on the basis of the print condition of the print data and a print ability of each of the plurality of print shops; selection means for selecting a print shop to order print processing of the formed print data, from among the print shops judged by said judgment means as the print shops which can print the formed print data, and a print order forming means for forming a print order, including the designation of a the selected print shop.

Shiohara '754 discloses a judgment means for judging whether each of the plurality of print shops included in the received print shop information, can print the print data formed by said print data forming means, on the basis of the print condition of the

print data and a print ability of each of the plurality of print shops (column 14, lines 27-

43; The "print processing information" of all printers 31 is obtained (print shop

information) in response to the temporary print request (print data formed; see (column

9, lines 52-67)) submitted to all the printers. Each printer 31 is judged to be match for

print data based on printing content ("print condition") and printer 31 status (print ability).

(column 14, lines 44-52; column 11, lines 6-67; column 12, lines 1-5).); selection means

for selecting a print shop to order print processing of the formed print data, from among

the print shops judged by said judgment means as the print shops which can print the

formed print data, and a print order forming means for forming a print order, including

the designation of a the selected print shop (column 14, lines 52-67; column 15, lines

22-29; printer is selected in step 47. column 15, lines 39-43; print request to specific

printer (designation of the selected shop).).

Having the system of Whitmarsh et al '585 and then given the well-established

teaching of Shiohara '754, it would have been obvious to one of ordinary skill in the art

at the time of the invention was made to modify the system of Whitmarsh et al '585 as

taught by Shiohara '754, since Shiohara '754 stated in col. 2, Lines 11-30, such a

modification would provide a faster printing system in a printing network.

Regarding claim 25, see Rejection of claim 20 as shown above. The apparatus

of Whitmarsh et al '585 in view of Owa et al '971 further in view of Shiohara '754 renders

obvious the program steps of claim 25.

Regarding claim 27, see Rejection of claim 20 as shown above. The apparatus of Whitmarsh et al '585 in view of Owa et al '971 further in view of Shiohara '754 renders obvious the method steps of claim 25.

Regarding claim 29, Whitmarsh et al '585 in view of Owa et al '971 further in view of Shiohara '754 teaches all the limitations of claim 20. Further Whitmarsh et al '585 discloses an apparatus according to claim 20, wherein each of the use condition and the print ability includes at least one of a page size, a media type, a page layout and a finishing option (column 10, lines 37-44; See "attributes").

Other Prior Art Cited

4.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 7099928 to Aoki et al disclose network printing.

U.S. Patent No. 7242490 to Palmer et al disclose printing system.

U.S. Patent No. 6757749 to Aoki et al disclose network printing.

Conclusion

5.   Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and

any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing

date of the advisory action. In no event, however, will the statutory period for reply

expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to BENIYAM MENBERU whose telephone number is (571)

272-7465. The examiner can normally be reached on 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, David Moore can be reached on (571) 272-7437. The fax phone number for

the organization where this application or proceeding is assigned is **571-273-8300**.

Any inquiry of a general nature or relating to the status of this application or

proceeding should be directed to the customer service office whose telephone number

is (571) 272-2600. The group receptionist number for TC 2600 is (571) 272-2600.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for published

applications may be obtained from either Private PAIR or Public PAIR. Status

information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov/>.

Should you have questions on access to the Private PAIR system, contact the

Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Patent Examiner

Beniyam Menberu

/Beniyam Menberu/
Examiner, Art Unit 2625

09/05/2008

/David K Moore/

Supervisory Patent Examiner, Art Unit 2625